

tesa AG 687-HCL
101769-79
3162-St-sti

REMARKS

Status of claims

Claims 1-13 remain pending. The amendments to the claims have been made to address the examiner's 35 U.S.C. 112, second paragraph rejection and to correct minor typographical errors to better place the application in condition for appeal. It is believed that no new matter has been added.

35 U.S.C. 112, second paragraph rejections

It is believed that the amendments have been made in accordance with the examiner's request and as such these rejections have been rendered moot.

35 U.S.C. 102(b) rejection

Claims 1, 2 and 4 were rejected by the examiner as being anticipated over Crass et al. (U.S. Patent 4,673,611).

The examiner did not appear to refute the substance of the applicants' previous response (i.e. what is the factual basis for the examiner's comment that "release" substance in a polymeric layer weakens the 'cleavage strength' of the resulting layer?) - the passage in col. 2, lines 24-32 makes no such assumption nor provides any basis for such a statement.

Crass et al. is relied upon as some elements of their invention is the same as the applicants claimed invention. However, Crass et al. lacks any teaching or suggestion for the applicants' limitation "wherein the cleavage strength of the composite backing is less than the bond strength of the adhesive.". The Examiner asserts that the presence of an anti-adhesive substance inherently creates this structural limitation.

Whether an invention is anticipated is a question of fact. *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995). However, there has been no factual support for the differences between Crass et al. and the applicants invention only a vague assertion of inherency. There is no teaching or suggestion from within the reference that such an inherent relationship exists and that there is further factual evidence which supports this assumption of inherency. MPEP 2112 (Requirements of Rejection Based on Inherency; Burden of Proof) states "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that

tesa AG 687-HCL
101769-79
3162-St-sti

result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).....To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), see also *Mentor H/S, Inc. v. Medical Device Alliance, Inc. (Mentor II)*, 244 F.3d 1365, 58 USPQ2d 1321 (Fed. Cir. 2001) and *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) – bold and italics added by author for emphasis.

Moreover, "The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation. The principles underlying application of the criteria of enablement to the content of the prior art were discussed in *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985):

It is well settled that prior art under 35 U.S.C. 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it is not enabling. It is not, however, necessary that an invention disclosed in a publication shall have actually been made in order to satisfy the enablement requirement.

Id. at 533, 226 USPQ at 621. See also *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1962) ('the disclosure must be such as will give possession of the invention to the person of ordinary skill. Even the act of publication or the fiction of constructive reduction to practice will not suffice if the disclosure does not meet this standard.')." *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, pg. 8, No. 00-1467 (Fed. Cir. Oct. 3, 2003), available at <http://www.fedcir.gov/opinions/00-1467a.doc>). In the present situation, there is no sense that Crass et al. has sufficiently described the invention such that it has been placed in possession of the public or that it has been enabled.

For any of these reasons, it is believed that the examiner would be justified in rescinding the rejection based on Crass et al.

tesa AG 687-HCL
101769-79
3162-St-sti

35 U.S.C. 103(a) rejection

- (1) Claims 1-9 and 11-13 were rejected by the examiner as being obvious over applicants' alleged admissions in the specification at page 3, lines 10-17 and page 6, lines 9-12 taken alone or in view of Allegre (FR 2,749,316).

It was not quite clear what the examiner was referring to when stating that no response was given to this rejection as a response was given on page 6 of the response dated 1 July 2003 which is to be considered repeated here.

The only additional comment offered by the examine is an acknowledgment that the admission does not teach using "oriented" films but that such films are extremely well known in the packaging and related arts. It is unclear what point is attempted to be made here, but if the examiner is taking "official notice", the applicants hereby formally request that a reference in support of this position be offered with the Examiner's Answer (should this be necessary).

If the statement was made because the modification is "well within the skill" of one of ordinary skill in the art, then the applicants would reply that MPEP 2143.01 further states that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993)."

However, even if these arguments were not deemed to be persuasive, the prior art still does not address the fact that the passages referred to by the examiner only partially describes the film component of the applicants' invention. The "admission" fails to teach a tape or that the film is part of a composite backing or that the film is oriented, coextruded and at least a two-layer polypropylene film. Moreover, the recitation of adhesive composition details how the concept of the applicants' invention can be applied to similar films. There is no admission that it was known to add an adhesive composition to the films described in the paragraph (lines 10-17) of page 3 of the specification.

Moreover, there is no address of the applicants' previous arguments that Allegre may disclose

lesa AG 687-HCL
101769-79
3162-St-sti

notches in the tape structure, but there is no teaching or suggestion from either "admission" (page 3, lines 10-17 of the specification), "admission 2" (page 6, line 9-12 of the specification) or Allegre to combine these elements. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990).

"Admission 2" merely states that certain adhesive technologies are known in the art. There is never any teaching or suggesting to combine this old component in the manner claimed by the applicants.

If the combination of references were made because it is believed that modifications to inventions of "simple" technology (which is not conceded by the applicants) are inherently obvious or have high presumption of obviousness, this still does not preclude providing a motivation to combine the references to arrive at the appellants' claimed invention nor does this lessen the standard for engaging in hindsight reconstruction. It was previously presented in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999) that:

"...Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.'...Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."

see *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, (Fed. Cir. 1999).

- (2) Claim 3 was rejected by the examiner as being obvious over Crass et al., *id.*, in view of Allegre (FR 2,749,316). The comments made above with respect to Crass et al. are to be considered repeated here. Moreover, the rejection was addressed on page 6 of the response dated 1 July 2003 which is to be considered repeated here.

tasa AG 687-HCL
101769-79
3162-St-sti

Summarizing that response, even if all the necessary elements of the applicants' invention could be found in the combination of Crass et al. and Allegre, there is no reason or motivation from these references that would guide one of ordinary skill in the art without having the benefit of the applicants claim as a template at the time this application was filed to make the necessary combinations as asserted by the examiner.

- (3) Claim 10 was rejected by the examiner as being obvious over Freedman (U.S. Patent 5,876,816) alone or in view of applicants' alleged admissions, *id.*

The examiner again notes that the "...oriented" limitation is believed to be well within the ordinary [skill] of the art in the adhesive tape and tamper resistant label arts." as was made in the applicants' admission in view of Allegre rejection. The applicants' response to this comment made in the applicants' admission in view of Allegre rejection is to be considered repeated here.

The examiner again mentions his previous analogous art rationale but this is a side issue to the main question regarding obviousness based on the present combination of prior art/admission, i.e. even if all the necessary elements of the applicants' invention could be found in the combination of Freedman and applicants' alleged admission, there is no reason or motivation from this combination of information that would guide one of ordinary skill in the art without having the benefit of the applicants claim as a template at the time this application was filed to make the necessary combinations as asserted by the examiner.

While it appears that the applicants and the examiner are in disagreement as to whether adhesive tapes and labels constitute analogous art, there can be no question that they are not identical products. The question to be decided is whether one of ordinary skill in the art as of 28 December 2000 [the U.S. filing date of this application or 29 December 1999 if the claim for foreign priority is perfected] having the teaching of Freedman and the applicants alleged admission in his hands would have independently arrived at the applicants claimed invention? Given that a virtually infinite number of changes could have been made to the product of Freedman and that Freedman speaks to a different product than that described in the admissions, there is no *prima facie* obviousness.

teaa AG 687-HCL
101769-79
3162-St-st

General comment about 103(a) rejections

MPEP 2142 states that "[w]ith regard to the rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e. the reference teachings establish a *prima facie* case of obviousness) is more probable than not." When balancing the extensive reliance on "applicants' admissions" and prior art references which have differences from the claimed invention vs. the initial burden on the office to show why the applicant is not entitled to a patent in combination with the applicants' earlier arguments which pointed out additional differences between the prior art and the claimed invention and/or asserted that there was no basis for making the desired combination of teachings from the prior art as was asserted by the examiner, it is unclear how the prior art rejections made under 103(a) "compels such a conclusion [of *prima facie* obviousness]".¹ At best, the rejections represent a possibility that the claims could be obvious but that possibility is far less than the preponderance of evidence standard necessary to sustain a *prima facie* holding of obviousness. Therefore, it is believed that the examiner would be justified in withdrawing these rejections.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

¹ It is presumed that the examiner has been made aware of the effects of the *Festo* series of decisions on patent prosecution. If there is an amendment the examiner would like the applicant(s) to make (especially to an independent claim), this must be expressed in the office action as applicant(s) are no longer afforded the luxury of "guessing" what the examiner would find allowable.

As a reminder of the reasons why this is so, selected passages from the recent *en banc* decision by the CAFC on *Festo* (28 September 2003) are provided below:

"...we reinstate those holdings of *Festo VI* that were not disturbed by the Supreme Court. To begin with, we recognize that the Court expressly endorsed our [Federal Circuit's] holding that a *narrowing amendment* made to comply with any provision of the Patent Act, *including §112, may invoke an estoppel....When the prosecution history reveals no reason for the narrowing amendment, Warner-Jenkinson presumes that the patentee had a substantial reason relating to patentability*; consequently, the patentee must show that the reason for the amendment was not one relating to patentability if it is to rebut that presumption....In this regard, we reinstate our earlier holding that a patentee's rebuttal of the *Warner-Jenkinson* on *presumption is restricted to the evidence in the prosecution record*." see *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, No. 95-1066 (Fed. Cir. Sept. 26, 2003), available at <http://www.fedcir.gov/opinions/95-1066c.doc>